



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,335	08/31/1999	NOBUHISA YODA	04329.2158	1305

22852 7590 10/07/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

JONES, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 10/07/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/386,335

Applicant(s)

YODA ET AL.

Examiner

David L Jones

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on August 31, 1999. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
2. The information disclosure statement (IDS) submitted on February 21, 2002 was filed after the mailing date of the Specification on August 31, 1999. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 9, 10, 14-19 rejected under 35 U.S.C. 102(b) as being anticipated by JP Patent 10-42114.

Regarding claim 1, Uchibori discloses a system that comprises at least one digital copier (fig. 1, #2) that's within a system (paragraph (¶) 22) that serves as a destination for all documents that have been inputted through the copier. Uchibori discloses a storage means for storing the

Art Unit: 2622

document image or file inputted by through the digital copier and the information relating to same; it includes a transmitting means (§ 23) whereby the information relating to the document is transmitted to the storage means.

Regarding claim 2, Uchibori discloses a document input system wherein the storage means includes a sub-storage means (§ 23) provided so as to correspond to system respectively, for storing the document image, and the transmitting means includes sub-transmitting means (§ 23), provided so as to correspond to the system, for transmitting the document image to the sub-storage means.

Regarding claim 4, Uchibori discloses a document input system, wherein the digital copier comprises: job history storage means (§ 23) for storing history of various jobs including an input of the document image; and job history management means (§ 23), if an error occurs in transmission of an inputted document image to a system of a transmission destination, storing information indicating an occurrence of the error in the job history storage means.

Regarding claim 3, Uchibori discloses an input/output processing means achieved by the digital copier, which includes a document management means, whereby document image control (§ 22) is achieved. The document image control allows for control of all documents to decide their destination.

Regarding claim 5, Uchibori discloses a document input system that the image input control means generates a title (§ 23) for the document based on the information relating to the document inputted by the management means and stores the same with the document image.

Regarding claim 6, Uchibori discloses a document input system, wherein the image input control means assigns priorities (§ 26) to the information relating to the document image and it

Art Unit: 2622

would be inherent that it would allow for generation of the title for the document image based on the priorities.

Regarding claim 7, Uchibori discloses a document input system, that further comprises a second storage means in which data storing time is longer than that of the storage means (§ 23), and the transmitting means transfers the document image stored in the storage means and the information relating to the document image to the second storage means. The storage is accomplished in the main server.

Regarding claim 9, Uchibori discloses a document input system, wherein until resetting to the information relating to the document image inputted by the management means (§ 24) is specified or a predetermined time passes after the document image is inputted by the image input/output processing means, the image input control means treats the document image inputted by the image input/output processing means as a series of information.

Regarding claim 10, Uchibori discloses a document input system, wherein the transmission destination is a document filing system (§ 23), which is part of the main system server, the transmitting means determines a title of a document image based on the information relating to the document image stored in the storage means and the determined title and the document image corresponding to the determined title are transmitted to the document filing system.

Regarding claim 14, Uchibori discloses a document input system, wherein the transmission destination is a client computer having a program for document edition and the document image transmitted from the transmitting means is used by the program (§ 9).

Regarding claim 15, Uchibori discloses a document input system, further comprises sub-storage means (§ 23) for storing the document image transmitted from the transmitting means, wherein the transmitting means, after the document image stored in the storage means is stored in the sub-storage means, transmits the document image to the transmission destination.

Regarding claim 16, Uchibori discloses a document input system, further comprises a sub-storage means for storing a document image transmitted from the transmitting means, wherein the transmitting means, if the document image information stored in the storage means (§ 23) can be transmitted to the transmission destination, transmits the document image information to the transmission destination and if not, stores the document image information in the sub-storage means.

Regarding claims 17 and 18, Uchibori discloses a document input system, wherein a storage area of the sub-storage means is divided for the at least one system (§ 23).

Regarding claim 19, Uchibori discloses a document input method comprises: storing a document image inputted by a digital copier and information relating to the document image, the information relating to the document image including information about transmission destination; and reading the stored information relating to the document image periodically and transmitting the document image corresponding to the read out information relating to the document image to the transmission destination based on the read out information relating to the document image (§ 24).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Uchibori as applied to claims 1-7, 9, 10, 14-19 above, and further in view of Aikens et al. U.S. Patent 5,414,494.

Regarding claim 8, Uchibori discloses a document input system utilizing a digital copier, but he does not explicitly disclose whether errors are displayed on the unit or sent to the system. Whereas Aikens et al. discloses a process whereby errors are documented and communicated across the network to another device (column 5, lines 50-67, column 6, lines 1-16). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to include the process of Aikens et al. in the system of Uchibori that would allow for any errors in the system to be displayed on the unit or/and sent to the system to be stored for retrieval or displayed on a computer within the system.

Regarding claim 13, Uchibori discloses a document input system utilizing a digital copier, but does not explicitly disclose an individual groupware server. Although, Aikens et al. discloses a server that is configured central to or remote from devices with public, shared or private data storage (column 6, lines 43-66). Therefore, it would have been obvious to one skilled in the art at the time the inventions was made to allow the use of a main server to be divided into different areas and to allow transfer to the different areas, one being a groupware

Art Unit: 2622

server, where all members within a network would have access to all documents and to make any changes or to print out as required.

5. Claims 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Uchibori as applied to claims 1-7, 9, 10, 14-19 above, and further in view of Toyada et al. U.S. Patent 5,881,233.

Regarding claim 11 and 12, Uchibori discloses a document input system that transfers image files to other destinations, but Uchibori does not explicitly disclose the transfer to an email server, but does disclose the ability to generate from the image data a header management file that could be used for the subject of email. Whereas Toyada et al. discloses an email server (fig. 1, #9A) and a process of using same (column 1, lines 38-48). Toyada et al. further defines the ability to recognize a string of characters from a document generates a destination from the string of information and further including the data with the body of the email document (column 9, lines 26-45). Therefore it would have been obvious to one skilled in the art at the time was made to include the process of Toyada et al. in the system of Uchibori to give the ability to send the inputted image to an email server and to further send it as an email message.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Furukawa U.S. Patent 6,029,238 discloses a peripheral processing apparatus and at least one information processing apparatus, interconnected through a network included is a storage means for storing control information by which the information processing apparatus controls the peripheral apparatus through the network. Hu et al. U.S. Patent 5,459,579 discloses

Art Unit: 2622


a multifunctional document processing system receives document signals from a local or a remote device and processes the document signals utilizing a host computer for transmission to the local or remote device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (6:30am - 3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

dlj


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600